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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,084	01/31/2002	Wolfgang Streubel	BO-98DIV	4889

7590 09/16/2003  
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EXAMINER

KASTLER, SCOTT R

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 09/16/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/066,084

Applicant(s)

STREUBEL ET AL.

Examiner

Scott Kastler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 10-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/460,333.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 10-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Instant claim 10 (from which claims 11 and 12 depend) recites, in proper means-plus-function format, both a “means for shaping” and “a means for positioning”. However, neither of these means are either described or even discussed in the specification as originally filed, thereby not enabling one of ordinary skill in the art at the time the invention was made to make or use the invention as instantly claimed.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kowalski et al in view of Umemoto et al and the ASM Handbook, Vol. 4. Kowalski et al teaches a system for manufacturing elongate structural parts (22) including a means for shaping a steel blank into the elongate structural part (40), an induction element (52) and downstream cooling unit (54)

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adapted to surround the formed part, thereby showing all aspects of the above claims except the positioning of the induction heating and cooling elements on a tool carriage for movement vertically while treating the vertically positioned part, means for positioning the elongate part vertically for heat treatment, or the adjustable positioning of the cooling element relative to the induction element. Umemoto et al teaches that when heat treating general elongate members (1), it was known in the art at the time the invention was made to vertically arrange the member to be treated and then conduct a heat treatment employing an inductor element (3) and following positionable multiple cooling elements (4) mounted on a tool carriage (33), and that this arrangement affords improved heat treating results (see col. 1 lines 45-57 for example). The ASM Handbook, Vol. 4 teaches that it was also known in the art at the time the invention was made to employ workhandling equipment enabling the vertical positioning of structural members to be heat treated by induction heating means (see page 183 under "Workhandling Equipment"), as well as also teaching that structural members (see page 196 under "Through-Hardening Applications") were known at the time the invention was made to be inductively hardened in a vertical orientation with an induction coil and following separate multiple cooling element quench ring (see page 195, quench system (f) used for through hardening, which as explained above is applicable to structural elements of the type described by Kowalski et al). Because improved heat treating quality would also be desirable in the system described by Kowalski et al, and vertical induction heat treatment was known in the art at the time the invention was made as being appropriate for elongate structural members, as taught by the ASM Handbook, Vol. 4; motivation to include both a vertical induction heat treating system, as taught by Umemoto et al, as well as a vertical positioning means to position the workpiece to be heat treated vertically,

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taught to be known in the art at the time the invention was made by the ASM Handbook Vol.4, to heat treat the elongate structural member of Kowalski et al, would have been a modification obvious to one of ordinary skill in the art at the time the invention was made.


### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Both McNulty et al and DelPaggio are also cited as further examples of prior art induction heat treatment systems for elongate structural members.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Kastler whose telephone number is (703) 308-2506. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (703) 308-3050. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

  
Scott Kastler  
Primary Examiner  
Art Unit 1742

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